R E M A R K S

- Claims 1 – 46 and 54 – 56 are pending in the present application.
- Claims 1, 34 to 36, 39 to 43, and 45 are independent.

1. Allowed Claim

Applicants gratefully acknowledge Examiner's statement that claim 35 is allowed.

2. Allowable Claim

Applicants gratefully acknowledge Examiner's statement that claim 27 would be allowable if rewritten in independent form. Applicants have not so amended claim 27 at this time, pending reconsideration of the claims in light of the present Response.

3. Section 102 Rejection of Claims

2(a). Claims 1, 6, 8, 9, 11, 33, 34, 43 and 44

Claims 1, 6, 8, 9, 11, 33, 34, 43 and 44 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,871,398 to Schneier et al. ("Schneier" herein).

Pursuant to 37 C.F.R. 1.78(a), Applicants have amended the specification herein to claim priority to Application Serial No. 09/063,590, which claims priority to Schneier. Accordingly, Schneier no longer qualifies as prior art against the pending claims.

2(b).   Claims 1, 2, 5 – 12, 15 – 19, 25, 26, 28 – 30, 36 – 40 and 43 – 46

Claims 1, 2, 5 – 12, 15 – 19, 25, 26, 28 – 30, 36 – 40 and 43 – 46 stand rejected under 35 U.S.C. §102(b) as being anticipated to U.S. Patent No. 5,042,809 to Richardson ("Richardson" herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Richardson does not teach or suggest allocating a payout, or anything else, based on "a parameter specified by a player" as is claimed. Richardson discloses that an entity programming the game of chance allocates a "total possible payout" among a finite "number of chances" (See, for example, Table 1 in columns 7 – 8). The player does not specify any parameter that is used to allocate the total possible payout among a finite number of chances. The entity constructing the game (which is not the player) decides on the total possible payout, the price per chance, the total number of chances and how the total possible payout is to be allocated among the chances. This allocation is determined and programmed into the game before the game is ever presented to the player. Accordingly, it would not even be possible to allocate a payout among a number of chances based on a parameter specified by a player. For these reasons, Applicants respectfully submit that the claimed embodiments are not anticipated by Richardson and the claims should be allowed.

Applicants further submit that no prima facie case of anticipation has been made with respect to claims 1, 2, 5 – 12, 15 – 19, 25, 26, 28 – 30, 36 – 40 and 43 – 46 in view of Richardson. Anticipation requires identity of the claimed process and a process of the prior art; the claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. Minnesota Min. & Mfg. Co., v. Johnson & Johnson Orthopedics, Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); Glaverbel S.A. v. Northlake

Mkt'g & Supp., Inc., 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). The elements of the claim must either be inherent or disclosed expressly in the reference. Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988). Further, the elements in the prior art must be arranged as they are in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9USPQ2d 1913 (Fed. Cir. 1988). There must not be any differences between the claimed invention and the prior art disclosure, as viewed by a person of ordinary skill in the art, for anticipation to exist. Scripps Clinic & Res. Found. v. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). Thus, the absence of any claim element from the reference negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

The Examiner has not shown, or even asserted, that Richardson describes allocating an outcome, or anything else, "based on a parameter specified by a player." Rather, the Examiner has asserted that Richardson describes "based on the number of tickets that all players select, allocating the total prize winnings amongst the total number of tickets." First, this is not a limitation of the claim. Second, the Examiner has not shown how this teaching, even if true, would anticipate the claimed feature of allocating a payout "based on a parameter specified by a player."

Further, Applicants respectfully disagree that Richardson teaches allocating the total prize winnings amongst the total number of tickets "based on the number of tickets that all players select." Richardson describes allocating total prize winnings among a total number of tickets based on a preference of an entity constructing the game and the total number of tickets available for the game. The number of tickets actually selected by players has no effect on how the total prize winnings are allocated among the tickets. The allocation of the total prize

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winnings among the total tickets available for a game is performed before any selections of tickets by any players. In fact, the total number of tickets that all players select is not known until the game is over. Accordingly, it would not make sense to allocate prize winnings based on this factor.

2(c). <u>Claims 1 – 26, 28 – 32, 36 – 43, 46 and 54 – 56</u>

Claims 1 – 26, 28 – 32, 36 – 43, 46 and 54 – 56 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,068,552 to Walker et al. ("<u>Walker</u>" herein). Applicants respectfully traverse this rejection for the reasons set forth below.

Applicants have amended the specification herein to claim priority to <u>Schneier</u>. Accordingly, based on the earlier effective filing date of the present application due to this amendment, <u>Walker</u> no longer qualifies as prior art under either 35 U.S.C. §102(a) or §102(b).

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461 - 7041 or via electronic mail at mfincham@walkerdigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a one month extension of time with which to respond to the Office Action. If an additional extension of time is required in addition to that requested, please grant a petition for that extension of time which is required to make this Response timely.

Please charge as follows:

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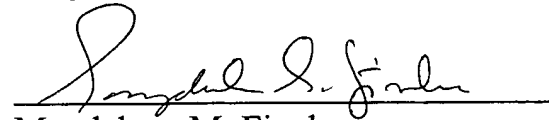
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A duplicate copy of this authorization is enclosed for such purposes.

Respectfully submitted,

June 01, 2004
Date

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